

REMARKS

In the Office Action of October 2, 2002, Claims 4 and 12 were rejected under 35 USC §112 for depending upon a cancelled claim. That rejection has been overcome by amendment. This amendment should be entered because it raises no new issues.

The office action reiterates all of the reasons espoused in the prior office action and adds the additional reference of Oshima to show that others disclosed unique and separate disc identifiers (DIDs) and software identifiers (SIDs).

To summarize the rejection, the claims are rejected as obvious on grounds that Yamagishi shows a hybrid optical recording disc with a DID and an SID. Spitzenberger is cited for showing that a DID may be inserted into the sub-codes of a master read-only memory device. Finally, Oshima is cited on grounds it discloses separate disc identification codes and software identification codes.

On page 6 of the office action, the rejection further rejects the application based upon the Windows XP operating system and upon AUTOCAD. Applicants traverse that rejection. Indeed, if the rejection is correct with regards to XP, that is an indication of non-obviousness for the reasons that follow.

Applicants filed their application on September 10, 1999. Applicants believe that Windows XP was not released until 2001. As such, it is impossible for a Windows XP operating system to be prior art against the invention. However, if the Examiner is correct and the Windows XP operating system uses the invention, then that is an indication of non-obviousness. Imitation of the invention by others in the field especially by an enterprise as large as Microsoft, would be a clear indication of the desirability of the features of the invention. As for the AUTOCAD reference, applicants traverse that rejection. The rejection fails to cite any reference to support that rejection. Applicants are not familiar with AUTOCAD and request a reference that shows the basis for the AUTOCAD rejection.

The art of record does not show or suggest the invention of Claims 2 and 10. In order to reject the claims under section 35 USC §103, the art must show each and every feature of the claims in the multiple references. In addition, the art must provide a motivation to select and combine the elements of the claims from the references. Although that motivation may not be in express language, nevertheless, the references must be consistent or at least not teach away from the combination.

● Claims 2 and 10 provide that the DID is not transferred. Applicants rely upon using subcode portions of the hybrid disc to prevent transfer of the DID. Yamagishi does not disclose using subcode and fails to disclose preventing transfer of its ID code.

Claim 10 further specifies that the DID is common to a number of other discs and its SID is unique for each disc. This feature is not shown in Yamagishi and is contrary to the successful operation of the Yamagishi system.

The Yamagishi system teaches away from the invention. The Yamagishi system relies upon using the same code in the RAM and ROM. It puts a common ID code in the RAM and ROM portions of the disk and reads the common IDs from both locations and compares them to each other. If they are the same ("coincident"; col. 2, lines 36-48) the program runs; otherwise it aborts. However, claim 10 requires that the SID is unique. If it is unique, it cannot be the same as the DID. If Yamagishi loads a disc where the SID is not the same as the DID (and as provided by the invention), the program aborts. Because Yamagishi aborts hybrid discs that are protected by the invention, Yamagishi would not lead one skilled in the art to the invention.

Yamagishi is a limited system and fails to provide the manufacturer and customer with improved security, flexibility and variety of choices. The invention allows a manufacturer to produce a large number of hybrid discs with the same DID. The manufactured discs can be shipped to software vendors who can add programs to the discs and protect each program with a unique SID that is unknown to the manufacturer. The software vendor can order a lot of discs with a common DID code and then choose unique SID codes for each program installed on a disc. However,

with Yamagishi, the software vendor must accept the unique code for each disc that is impressed into the disc at time of manufacture and can use only that unique code as an SID. With the invention, the DIDs and SIDs are independent of each other. In contrast, Yamagishi's system requires the DID and SID to be identical.

Yamagishi teaches away from combining its system with the Spitzenberger system and one skilled in the art would not be led by Yamagishi to use the hardware dependent system of Spitzenberger. In its background Yamagishi points out that it is desirable to avoid using hardware to carryout a copy protection system. However, Spitzenberger's system depends upon hardware. Spitzenberger requires at last three circuits within the processing circuit 97 to carry out its copy protection scheme. See Figure 9 and columns 10, lines 1-50. Under Spitzenberger's scheme, sub-codes in the addresses are mixed at one or more points. In other words, the addresses do not increase uniformly or sequentially. Circuit 97 looks for address values that depart from incremental increases. When it finds those, it allows copying of the program or playing of the program. If it does not find them, it aborts. The Spitzenberger reference depends upon the hardware found in Circuit 97 and is little more than a conventional hardware key system and is contrary to both Yamagishi and to the invention.

The Oshima reference likewise leads one away from the invention. Oshima relies upon a distant network, encryption and a semi-public key for copy protection. Even if one assumes that Oshima provides DID and SID codes, Oshima fails to show or suggest how to place those codes on a disc in order to provide a disc-based copy protection scheme. The Examiner's attention is directed to column 6 lines 7-18 of Oshima where Oshima's two IDs are sent or otherwise communicated to a third party for confirmation. The third party then creates a password that is returned to the user. The personal computer at the user end decrypts the password using a public key and then compares the decrypted password to the DID and SID on the disc. The Oshima system depends upon key-based encryption system and a network. The invention needs neither one. Keys and network connections are also contrary to Yamagishi.

Claims 4 and 12 are patentable over the art of record for the same reasons given above.

Claims 5 and 13 were rejected based upon the combination of Yamagishi and Spitzenberger. As shown above, Yamagishi is silent regarding transfer of the DID and the Yamagishi system is incompatible with separate DIDs and SIDs. Yamagishi teaches a way from a hardware-based technique and the Spitzenberger system depends upon hardware circuitry for interpreting an address pattern.

Claims 6 and 15 are patentable over the art of record. Those claims were rejected based upon the combination of Yamagishi and Spitzenberger. As pointed out above, Yamagishi does not show the transfer prevention feature of the invention. The two references are incompatible because Yamagishi strives to eliminate hardware in its copy protection system and the Spitzenberger reference depends upon hardware Circuit 97.

Claim 9 is patentable over the art of record. Its rejection was based upon Yamagishi and the combination of Yamagishi with Spitzenberger, Oshima, the Windows XP operating system and AUTOCAD. For the reasons given above in connection with claims 2 and 10, Claim 9 is patentable over the art of record.

Claim 11 is an apparatus claim and it is rejected based upon the combination of Yamagishi, Spitzenberger and Oshima/Windows XP/AUTOCAD discussed above. For the same reasons discussed above in connections with Claims 2 and 5, Claim 11 is patentable over the art of record. Claim 11 is also patentable because none of the art of record shows or suggests copy protection wherein multiple discs have the same disc identifier data and each disc has a unique software identification data. This feature is contrary to Yamagishi and Spitzenberger.

Claim 14 is rejected based upon the combination of Yamagishi, Spitzenberger, Oshima and the Windows XP operating system discs and AUTOCAD. Claim 14 is dependent upon Claim 13 and claims a hybrid optical recording disc that has a common DID on a plurality of other hybrid operating discs but a unique software identifier data that is different from the software identifier data on other discs. While the Oshima, Windows XP and AUTOCAD references have been separately distinguished above, applicants also wish to point out that nowhere does the rejection

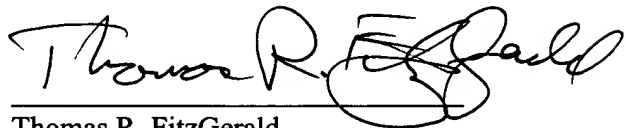
expressly show a common DID for multiple discs coupled with the unique SID for software on each disc.

Applicants also point out that this final rejection is premature and the finality of this rejection should be withdrawn. Independent Claim 2 and independent Claim 4 were not amended after the first office action. In response to the initial rejection, applicants argued that Claim 2 was patentable over the art of record. In the final office action, the examiner cites Oshima, Windows XP operating disc, and AUTOCAD in order to provide support for showing software and disc identifier data. That belated citation of further references against original claims, while certainly permitted, renders the final office action improper. It should be withdrawn and should be corrected to be a non-final office action.

Having thus distinguished the invention from the art of record, applicants submit that this application is now a condition for allowance.

Respectfully submitted,

Dated: 12/02/02



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Docket#:
79927/RLO

MARKED UP ADDENDUM SHOWING AMENDMENTS MADE TO THE
CLAIMS

4. (amended) The hybrid optical recording disc of claim [3] 2 wherein the recordable area of the hybrid optical recording disc includes a recordable program area for recording therein data generated by a computer user and for reading such recorded data from the recordable program area to the computer.

12. (amended) The hybrid optical recording disc of claim [3] 11 wherein the recordable area of the hybrid optical recording disc includes a recordable program area for recording therein data generated by a computer user and for reading such recorded data from the recordable program area to the computer.